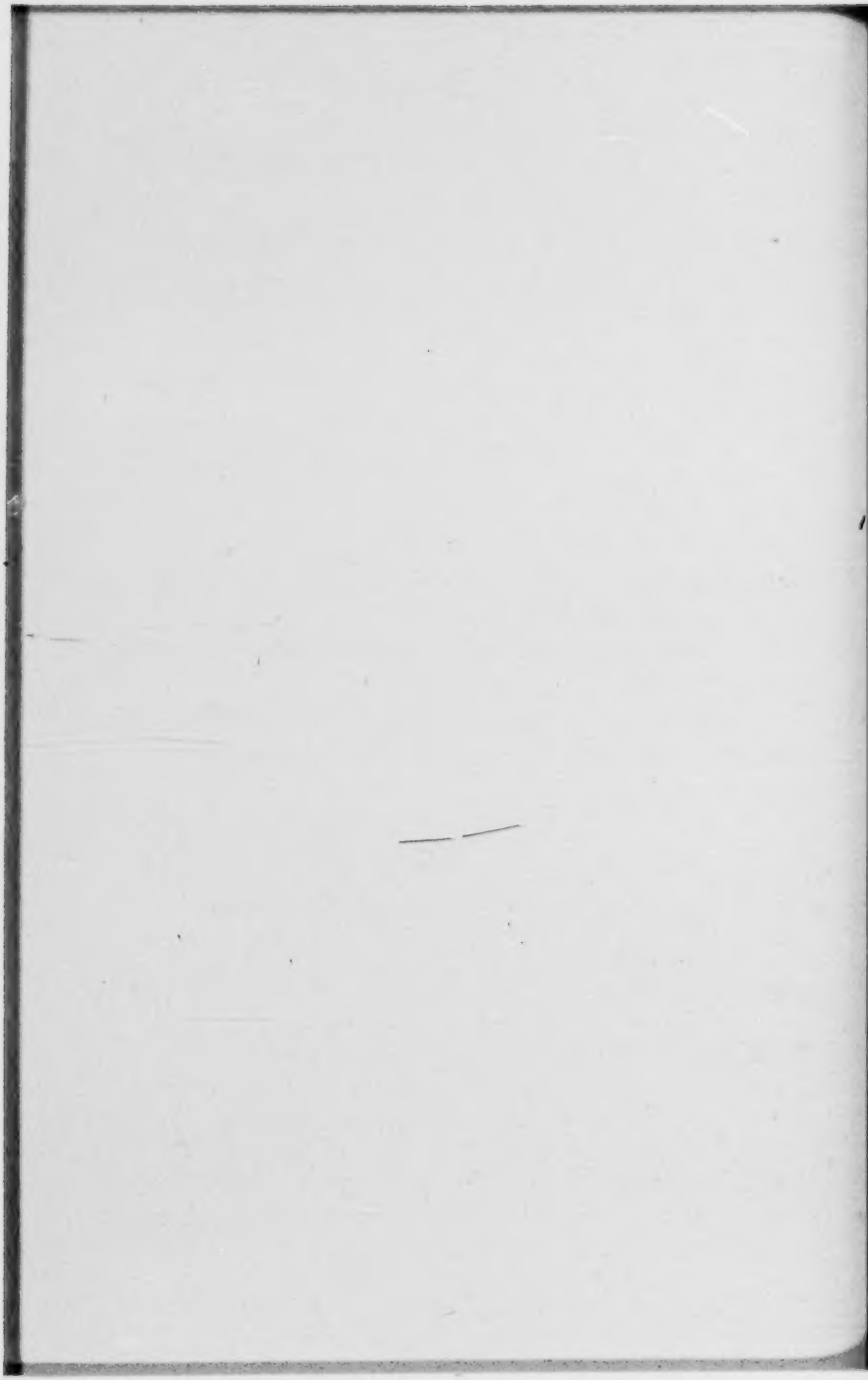

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FILED
JUN 7 1946
CHARLES ELMORE CROPLEY
CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1945.

No. 1233.

THE E. L. ESSLEY MACHINERY COMPANY, an Illinois Corporation, *Petitioner*,

v.

THE DELTA MANUFACTURING COMPANY, a Wisconsin Corporation, *Respondent*.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

WILLIAM A. STRAUCH,
Counsel for Respondent.

J. MATTHEWS NEALE,
STRAUCH & HOFFMAN,
Of Counsel.

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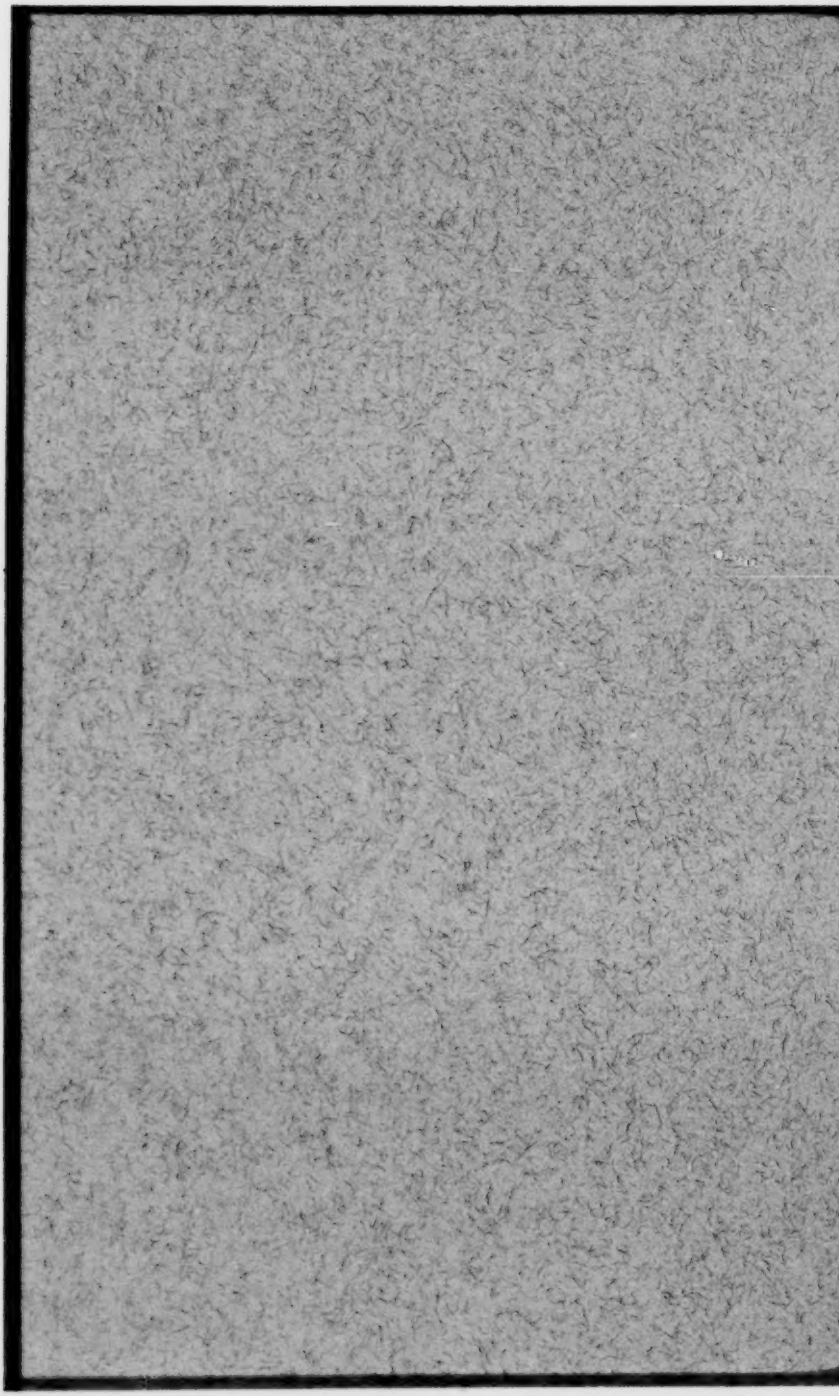

INDEX.

	Page
Opinions Below	1
Jurisdiction	1
Questions Presented	2
Supplement to Statement of the Case	2
Summary of Argument	6
Argument	7
Point 1	7
Point 2	9

CITATIONS.

Altoona Publix Theatres, Inc. v. American Tri-Ergon Corp., 294 U. S. 477, 487 ..... 2, 6
Benoit v. Wadley Co., 54 F. (2d) 1041, 1044 ..... 6, 8
The Corn Planter Patent, 90 U. S. (23 Wall.) 181, 218.. 6, 8
Goodyear Tire & Rubber Co. v. Ray-O-Vac Co., 321 U. S. 275, 279 ..... 7, 11
Lincoln Co. v. Stewart-Warner Corp., 303 U. S. 545, 546 ..... 2, 6
Morton Salt Co. v. Suppiger Co., 314 U. S. 488, 490 .... 2, 6
Paramount v. Tri-Ergon Corp., 294 U. S. 464, 474 ..... 7, 11
Schram Glass Mfg. Co. v. Homer Brooke Glass Co., 263 F. 903 ..... 6, 8
Schriber Co. v. Cleveland Trust Co., 311 U. S. 211, 217 . 2, 6
Seymour v. Osborne, 78 U. S. (11 Wall.) 516, 547 ..... 6, 8
Westinghouse v. Boyden, 170 U. S. 537, 557, 558 ..... 6, 8

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RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE CIRCUIT COURT OF APPEALS FOR THE SEVENTH CIRCUIT.

Opinions Below.

The opinion of the District Court of the United States for the Eastern District of Wisconsin (R. 209-214) is not reported. The opinion of the Circuit Court of Appeals (R. 310-314) is reported, 153 Fed. (2d) 905.

Jurisdiction.

The order of the Circuit Court of Appeals (R. 314) affirming the decree of the District Court (R. 220) was entered on February 28, 1946, and defendant's petition for re-hearing (R. 315-324) filed on March 14, 1946, opposed by plaintiff (R. 327-330) was denied by the order of the Circuit Court of Appeals (R. 331) entered April 3, 1946. The peti-

tion for a writ of certiorari was filed on May 16, 1946. Jurisdiction of this Court is invoked under Section 240(A) of the Judicial Code (28 U. S. C., 347, as amended) and the cases of *Lincoln Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 546; *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 217; *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 487; and *Morton Salt Co.* v. *Suppiger Co.*, 314 U. S. 488, 490.

Questions Presented.

The questions presented are whether the courts below properly held claims 6, 7 and 8 of patent 2,069,395 valid and whether the courts below improperly interpreted the claims in suit by ascribing functions and results to the claimed combination entirely foreign to the combination of elements recited in the claims in denying anticipation and want of invention with respect to the claimed invention in suit.

Supplement to Statement of the Case.

Petitioner's statement of the case concedes infringement, if the claims are valid, and purports to seek a proper application of the law to the facts as distinguished from a retrial of the facts. Accordingly, it is respectfully submitted that the following fact findings of the District Court, affirmed by the Court of Appeals, are conceded by defendant and although omitted from petitioner's statement of facts we submit should be considered. These facts are:

The District Court found, from the testimonial and documentary evidence introduced at the trial, that the need for transparent shields to protect grinder operators was recognized and an attempt at solution was made as early as 1767 (F.* 7 R. 214, 215). This fact finding is fully substantiated by the trial evidence. (PX** 5 R. 44, 104, 105 and 125.)

The Court found further that prior efforts to solve the problems encountered in providing a satisfactory grinder

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* Refers throughout to District Court's Findings of Fact.

** Refers throughout to Plaintiff's Exhibit.

safety shield had been made and resulted in failure to satisfy the art, (F. 8. R. 215). This finding likewise is fully supported by the documentary and testimonial evidence introduced at the trial. (PX 4B, 4C, 9B, 17 and 18, R. 256, 276, 147, 159, and 161 respectively; DX*-A to C-3, G, H, J, N and O, R. 163 to 179, 252, 270, 280, 191 and 193 respectively; the testimony of plaintiff's witnesses Doyle, R. 14 to 20; Melius, R. 30, 31; Martin, R. 36; Heinrich, 39, 41; Wiken, R. 43, 44, 47, 56, 57, 73, 112-122; Rasmussen, R. 105-107, 109-111; and Defendant's own witnesses Bernitt and Mickelson, DX-N, R. 191-193.)

Defendant's own expert, McNulty, chose the single bulb Surty shield, (PX-9B, R. 147, DX-A), the Acme single bulb shield made under patent 1,633,412 to Kelleher (PX-4c and PX-6, R. 276, 129) and the Boys Tech shields (DX-C and DX-C^1 to DX-C^3, R. 175-179) as the closest prior art to the patent in suit and the Lindsay and Jones patents 1,960,114 (DX-L, R. 296) and 1,952,073 (DX-M, R. 284) as the closest patented art (R. 94, 95). The District Court found, among other things, that the single bulb Surty shields, the Boys Tech shields, and the Acme single bulb shields of patent 1,633,412, did not satisfactorily supply this need and were among the prior efforts and failures to solve the problems overcome by the Tautz patent in suit. (F. 8., R. 215). The District Court also found that the viewing devices of Lindsay patent 1,960,114 and Jones patent 1,952,073 could not be used as grinder safety shields and do not suggest the safety shield of Tautz patent 2,069,395 in suit (F. 9, R. 215). This finding is amply supported by the testimony adduced at the trial. In this connection defendant's own witness Bernitt said: (Paragraph 3 of DX-N, R. 191):

> "* * * In these Surty shields if the light is back too far, there is a shadow cast on the wheel, the work support, and the work by the wheel and wheel housing, and if the shield is moved forward to eliminate the shadow, it brings the glass so far forward that it is

* Refers throughout to Defendant's Exhibit.

> difficult to see the wheel without getting into an awkward position which makes it dangerous."

The awkward position referred to is well illustrated by PX-17 (R. 159).

The Surty Company who manufactured the Surty single bulb shields as early as 1923, and about 1926 undertook to sell the Acme shields made under the Kelleher patent 1,633,412, characterized the single bulb shield as inadequate in lighting, saying (PX-9B, R. 147):

> "In 1923, the shield to the left was the first successful illuminating SHIELD (called a Machine Goggle). It protected the face but was inadequate in lighting. Many and varied have been the steps of improvement until the E-Z Vision SHIELD on the right has been developed."

In speaking of the Jones and Lindsay patents, defendant's expert, McNulty, admitted that only an image of the actual object could be viewed through the structure of the Jones patent after it had been properly focused (R. 99), that many of the parts of the Jones structure would be unnecessary and should be discarded in adapting it to a grinder (R. 99, 100), that the magnifying glass of the Lindsay patent would distort the object as moved toward or away from the lens (R. 100), and that Lindsay disclosed a focusing of the light rather than mere balancing of light, as is done in the patented and accused structures (R. 101). From this evidence and the testimony of plaintiff's witnesses (R. 15, 18 to 20, 72, 73, 106 to 122), the Court found as a fact that no patent or publication, or prior use, or prior knowledge relied upon, made of record or proven in this cause shows or suggests a grinder shield capable of accomplishing all the desirable new results of finding 24 (F. 28, 29 and 30, R. 218).

The District Court also found that the viewing devices of Lindsay, 1,960,114 and Jones 1,952,073, and the single bulb Surty shields, the shields made at Boys Tech and the Acme shields made under the Kelleher patent 1,633,412, among

many other prior art patents relied upon, do not embody or suggest the teachings of claims 6, 7 and 8 of the Tautz patent in suit (F. 21, R. 216) and that no patent or publication, or prior use or prior knowledge relied upon, made of record or proven in this cause, shows or suggests the grinder shield embodying the structure defined by claims 6, 7 and 8 in suit (F. 25, 26, 27, R. 218). The evidence produced at the trial fully substantiates these findings (R. 14-20, 30, 31, 36, 39, 41, 43, 44, 47, 56, 57, 73, 112-122, 105-107, 109-111 and DX-N, R. 191-193) and the Court of Appeals affirmed these findings and the District Court's conclusions as shown by its opinion (R. 310 to 314), the wording of which clearly indicates a careful consideration of the testimonial and documentary evidence adduced at the trial.

The "Twin-Lite" safety shield made pursuant to Tautz patent 2,069,395 in suit, achieved commercial success through acceptance by mechanics, engineers and those skilled in the art on merit, and was not the result of any unusual advertising campaign (F. 20, R. 216) and its success was such that the Surty Company, manufacturers and vendors of the prior single-bulb shields of DX-A to AB-1 heavily relied upon by defendant, adopted and placed a two bulb shield substantially embodying the structure of the Tautz patent upon the market in 1937, accepted a license under the Tautz patent on June 27, 1938, and has been paying royalties ever since, (F. 16, R. 24, 25, 143, 216). The Boyer-Campbell Company, who make safety shields as well as inspection or examination devices for dentists, dermatologists and surgeons as asserted at page 4 of petitioner's petition for certiorari, took a license under the patent on September 30, 1942, and since that date has paid royalties on the grinder shields made by it (F. 17, R. 24, 25, 143, 216). It is significant, regarding this license, that royalties are paid on the sales of safety shields only as distinguished from the "medical gadget." (R. 28).

It is further shown that this commercial success was achieved by a small company in bad business times, without substantial advertising, in the face of low cost, national

chain store competition such as Sears Roebuck, Western Auto Supply and others, and in spite of the fact that plaintiff's "Twin-Lite" safety shields added substantially to the cost of the grinders and were introduced at relatively high prices as compared to the low-cost chain store competition. (F. 14, R. 31, 32, 37, 143, 215). As a matter of fact 25% of respondent's production of shields developed from use on grinders for which they were not designed and to which they had to be specially fitted by the purchasers. (R. 32, 37).

Summary of Argument.

Point 1. The special circumstances recognized by this court for exercising its jurisdiction under Section 240(a) of the Judicial Code (28 U. S. C. 347, as amended) in patent cases in the absence of diversity of opinion as to validity in the Courts of Appeals are not present in this case, there being a complete absence of the reading of an element into any claim in suit, and, therefore, the cases of *Lincoln Co.* v. *Stewart-Warner Corp.*, 303 U. S. 545, 546; *Schriber Co.* v. *Cleveland Trust Co.*, 311 U. S. 211, 217; *Altoona Publix Theatres, Inc.* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 487; and *Morton Salt Co.* v. *Suppiger Co.*, 314 U. S. 488, 490, do not sustain jurisdiction of this cause as contended by petitioner.

Seymour v. *Osborne*, 78 U. S. (11 Wall.) 516, 547;
The Corn Planter patent, 90 U. S. (23 Wall.) 181, 218;
Westinghouse v. *Boyden*, 170 U. S. 537, 557, 558;
Benoit v. *Wadley Co.*, 54 F. (2d) 1041, 1044;
Schram Glass Mfg. Co. v. *Homer Glass Co.*, 263 F. 903.

Point 2. The claims in suit specifically call for "A safety shield" and this expression used in each of the claims in suit fully justified the lower courts' reference to the specifications and drawings and consideration of the testimony as to the accomplishments and problems present in providing a satisfactory safety shield for grinders and other cutting machines requiring protection of the worker from flying sparks and particles in order to properly construe the

claims in suit and to apply the various criteria of invention repeatedly approved by this Honorable Court in determining the presence of invention.

Goodyear Tire & Rubber Co. v. *Ray-O-Vac Co.*, 321 U. S. 275, 279.
Paramount v. *Tri-Ergon Corp.*, 294 U. S. 464, 474.

Argument.

Point 1. In an effort to show that this case is outside of the general rule that the Supreme Court will not grant certiorari in patent cases in the absence of diversity of opinion between the Circuit Court as to the validity and infringement of the patent involved, petitioner asserts that the District Court and the Circuit Court of Appeals had recourse to the specifications "not for the purpose of construing what is set forth in the claims, but for the purpose of revising the claims to include elements not present therein" (Page 14 of the petition and argument) and that "The Court of Appeals made no analysis of the claims in suit, but treated them throughout as though they included or were directed to the combination of the shield with a grinding machine which is entirely foreign to the combination or structure defined by the claims." (Page 7 of the petition and argument).

While petitioner, at various points, asserts the Lower Courts' decisions interpret the claims as including elements not recited therein, namely a grinding machine and a special mounting of the safety shield thereon in relation to the grinding wheel, petitioner nowhere points out language of either of the Lower Courts, which is susceptible of such an interpretation of their decisions. This, we submit, is significant since the claims in suit, as well as the specifications, clearly call for "A safety shield" and the specification clearly defines the invention as a "safety shield for grinders" etc. and a device "which will effectively guard a user of a grinding wheel from flying particles and afford shadowless illumination of the wheel and work viewed through the shield." (R. 239, col. 1, lines 1 to 6). In de-

scribing the use of this shield, the very factors which the evidence shows resulted in solution of the problems in the safety shield art are briefly set forth in the patent specification (R. 240, col. 2, lines 29 to 47). This description itself clearly indicates that the solution of the safety shield problems resulted from the arrangement of the elements of the shield, not a particular mounting arrangement on a grinder, and the evidence regarding the unsuccessful (F. 8, R. 14, 16, 31, 36, 39, 41, 43, 215) prior art safety shields provided with universal mounting to secure every conceivable association merely emphasizes this fact.

While it seems clear from the facts that the clause "A safety shield" limits the scope of the claimed invention and, as a corollary, the available prior art, to devices capable of functioning as a safety shield and thus requires, as the courts below did, a consideration of the history of the safety shield art, the inadequacy of the prior art safety shields and viewing devices in solving the problems of the safety shield art, and the adequacy and commercial success of the patented structure as a safety shield in determining the validity of the claims in suit. Ample authority for so doing is found in the following decisions which, in view of the similar fact situations, distinguish this case from those decisions relied upon by petitioner in support of its petition. Ample authority for giving effect to the words "A safety shield" and referring to the specifications to determine the true invention and validity of the claims is found in this Honorable Court's decisions in *Seymour* v. *Osborne*, 78 U. S. (11 Wall.) 516, 547; *The Corn Planter Patent*, 90 U. S. (23 Wall.) 181, 218 and *Westinghouse* v. *Boyden*, 170 U. S. 537, 557, 558. While the foregoing cases do not specifically relate to the effect of an introductory clause as determining the meaning and scope of the claimed invention in sustaining the validity of the patent claims, the Seventh Circuit Court of Appeals decisions in *Benoit* v. *Wadley Co.*, 54 F. (2d) 1041, 1044 and *Schram Glass Mfg. Co.* v. *Homer Brooke Glass Co.*, 263 F. 903, we submit, applied the principles announced in the above mentioned deci-

sions of this Honorable Court by giving effect to the introductory clauses of claims.

It, accordingly, is respectfully submitted that the lower courts in this case properly applied the law to the undisputed facts of this case and that the facts so differ from those in the cases relied upon by petitioner as to render them inapplicable in the present cause.

Point 2. While petitioner's argument in support of its petition for certiorari attempts to belittle the criteria considered by the courts below in upholding the validity of the patent in suit, it is submitted that the lower courts properly held that the invention and the inventor's claimed protection relates to the safety shield art and properly read the combination of elements defined by the claims in suit in the light of the safety shield art and its history. Reference to the evidence adduced at the trial shows that the art of grinder safety shields dates back at least to the year 1767, when the familiar glass screen or panel was adopted by the French, (PX-5, R. 125), and that up until the patent in suit was offered on the market in 1935 a satisfactory grinder shield had never been offered to the trade. (F. 7, 8, 9, 10; R. 214, 215; Testimony R. 14-20, 30, 31, 36, 39-41, 43, 44, 47, 56, 57, 73, 105-107, 109-122, and DX-N, R. 191-193.) This long felt want and crying need was recognized in the patented art since at least February, 1897 (DX-G, R. 252) and an unsuccessful effort was made as early as 1923 to solve the problems with a lighted shield by the manufacturers of the prior art single bulb Surty shield relied upon by petitioner (PX-9B, R. 147). In addition, it is clear that the millions of mechanics who use grinding machines almost daily and who were subject to injuries, painful and frequently serious or fatal, knew these problems from at least the year 1767 but failed to solve them.

Furthermore, the technical staff of the Boys Tech High School in Milwaukee, including shop instructors and technical professors, such as petitioner's own witnesses Bernitt and Mickelson, and plaintiff's witness Rasmussen were

familiar with the problems and disadvantages of the best prior art shield, the single light Surty shield which they had in use, tried to improve it and the best they could produce were the single light Boys Tech shields of DX-C to DX-C-3 which also failed to solve the problems and to fill the long felt want of at least 150 years (R. 175-179, DX-N, R. 191-193). The evidence clearly shows that these various single light shields were unsatisfactory, unsuccessful and impractical, and that the illuminated viewing devices known to the art since 1896 (DX-K, R. 248) including the Mitchell patent 565,011, Lindsay patent 1,960,114 and Jones patent 1,952,073, could not be used as grinder shields without substantial alterations of the means disclosed (R. 14-20, 30, 31, 36, 39, 41, 43, 44, 47, 58, 73, 99-101, 105-107, 109-122) and that these prior devices do not disclose the construction of the patent in suit (R. 15, 30-33, 37, 39, 40, 42, 43, 44, 47, 64, 71, 106-109). In view of this testimony the court, properly we submit, held that the transparent shields of patents 596,762 to Sevison, 1,259,050 to Schofield, 1,759,941 to Frey (DX-G to DX-J R. 189, 252, 270) the single bulb Surty shield (DX-A to DX-AB-1, R. 163-173) the shields made at Boys Technical High School of Milwaukee (DX-C to DX-C-3, R. 175-179) and the shield of Kelleher patent 1,633,412 (PX-4C and PX-6, R. 129, 276) did not satisfactorily supply this long felt want and need and show prior efforts and failures of others in the art to solve the problems encountered in providing a satisfactory grinder shield (F. 8, R. 215). These facts, which are not refuted by any evidence submitted by the defendant, constitute the basis for the court's findings and are supported by respondents disinterested witnesses Doyle, safety inspector for the Industrial Commission of Wisconsin (R. 13); Rasmussen, instructor in the machine shop of Boys Technical High School of Milwaukee (R. 105); defendant's own witnesses Bernitt and Mickelson (DX-N, R. 191-192) and McNulty (R. 98); and from trade publications of general circulation (PX-5, PX-9B); as well as witnesses in the employ of plaintiff. The record clearly establishes a want or need unsupplied for

over one hundred and fifty years and as hereinbefore pointed out, remarkable commercial success by a small company founded by the inventor in open competition with the largest of the national chain distributing organizations such as Sears Roebuck, Western Auto Supply and many others with sales made at about twice the price of the competitive machines and about 25% of the sales made for use on machines for which the patented safety shields were not adapted, requiring special adaptations by such purchases. Surely this record warrants the lower courts in their application of the various criteria repeatedly and still recognized by this Honorable Court as evidence of invention, as shown by the decision of this court in *Goodyear Tire & Rubber Co., Inc., et al.* v. *Ray-O-Vac Co.*, 321 U. S. 275 and *Paramount* v. *Tri-Ergon*, 294 U. S. 464.

As a matter of fact, a want of half a century was deemed sufficient in applying the foregoing criteria in the Ray-O-Vac Case, in which Mr. Justice Roberts, speaking for the court in holding the patent in suit valid and infringed, said, page 279:

> "Viewed after the event, the means Anthony adopted seem simple, and such as should have been obvious to those who worked in the field, but this is not enough to negative invention. During a period of half a century, in which the use of flashlight batteries increased enormously, and the manufacturers of flashlight cells were conscious of the defects in them, no one devised a method of curing such defects. Once the method was discovered it commended itself to the public as evidenced by marked commercial success. These factors were entitled to weight in determining whether the improvement amounted to invention, and should in a close case, tip the scales in favor of patentability."

This reasoning has been consistently followed by this Honorable Court as shown by the decision in *Paramount Corp* v. *Tri-Ergon Corp.*, 294 U. S. 464, wherein Mr. Justice Stone, later Chief Justice, said, page 474:

"• • • Evidence of great utility of a method or device, it is true, may in some circumstances be accepted as evidence of invention. Where the method or device satisfies an old and recognized want, invention is to be inferred, rather than the exercise of mechanical skill. For mere skill of the art would normally have been called into action by the generally known want. See Loom Co. v. Higgins, 105 U. S. 580, 591; Krementz v. Cottle Co., 148 U. S. 556, 560; Hobbs v. Beach, 180 U. S. 383, 392; Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403, 429, 430; Expanded Metal Co. v. Bradford, 214 U. S. 366, 381."

While in the latter case the proofs were found not to have established the necessary old and recognized want, here where the evidence shows a need for one hundred fifty years; that the patented structure has solved the grinder shield problems (R. 15, 30-33, 37, 39, 40, 42-44, 47, 64, 71, 106-109, and DX-N, R. 191-193); that the Surty Manufacturing Company manufacturers of defendant's alleged prior art shields acknowledged the advance made by the patented structure by copying the twin light shield and then taking a license under the patent in suit (R. 24, 25); substantial sales were made in spite of higher prices, established chain store competition, the initial reluctance of salesmen and dealers and bad market conditions in the absence of advertising (R. 31, 32, 37, DX-8, R. 143); a spontaneous demand resulting in sales amounting to 25% of plaintiff's production of shields developed for use on other grinders for which they were not designed (R. 32); an even more striking history supporting the presence of invention than existed in the Ray-O-Vac case, is shown. It, accordingly, is respectfully submitted that the authorities relied upon by petitioner to support its petition for certiorari are not in point here, and that certiorari should not be granted.

Respectfully submitted,

William A. Strauch,
Counsel for Respondent.

J. Matthews Neale,
Strauch & Hoffman,
Of Counsel.